

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



#12

IN RE APPLICATION OF : Willibald Kraus  
FOR : BLOCKING OF RETURN AIR  
SERIAL NO. : 08/230,083  
FILED : April 20, 1994  
EXAMINER : H. Joyce  
ART UNIT : 3404  
LAST OFFICE ACTION : January 22, 1996  
ATTORNEY DOCKET NO. : TRW 2 136-4  
Cleveland, Ohio 44114-2518  
June 20, 1996

**REISSUE APPLICATION DECLARATION AND POWER OF ATTORNEY**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

As the below named inventor, I hereby declare that:

I verily believe that I am the first, original and sole inventor of the subject matter which is described and claimed in Letters Patent No. 5,105,731 granted on April 21, 1992 and in the foregoing specification and for which invention I solicit a reissue patent. The entire title to Patent No. 5,105,731 has vested in TRW United-Carr GmbH & Co., K.G. The assignment document is recorded on Reel 5621 at Frames 835-836.

I hereby state that I have reviewed and understand the contents of the above-identified reissue application including the additional claims therein.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with

37 C.F.R. 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior foreign Application No.: 4002052.5  
Country: Federal Republic of Germany  
Filed: January 24, 1990

STATEMENT OF INOPERATIVENESS OR INVALIDITY

I verily believe that my original Patent 5,105,731 dated April 21, 1992 to be partly inoperative or invalid because of error without any deceptive intent on the part of the applicant or the assignee.

The patent is partly inoperative or invalid by reason of claiming less than I had a right to claim in the patent. More particularly, the issued patent is partially inoperative or defective for failing to recite:

A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:

an outer housing having an open end and a surrounding wall;

an inner frame received in the open end;

a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

first and second resilient clip connections

joining the outer housing, the inner frame, the check valve element to a support of the motor vehicle, the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

Such an apparatus is recited in newly submitted independent claim 14.

The above mentioned error of failing to include claim 14 rendering said patent wholly or partly inoperative or invalid arose from inadvertence, accident, or mistake and without any fraudulent or deceptive intention on the part of the applicant.

The issued patent is also partially inoperative or defective for failing to recite:

A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:

an outer housing having an open end;

an inner frame received in the open end;

a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

a resilient clip connection formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing and the check valve element to the motor vehicle.

This apparatus is recited in newly submitted independent claim 16.

The above-mentioned errors of failing to include claim 16 rendering said patent wholly or partly inoperative or invalid arose

from inadvertence, accident, or mistake and without any fraudulent or deceptive intention on the part of the applicant.

These insufficiencies, i.e., failing to recite claims 14 and 16, came to the attention of the inventor and the assignee during the process of reviewing issued patents of the assignee. More specifically, during a competitive analysis conducted after issuance of the original patent, it was determined that the subject matter of claims 14 and 16 was disclosed yet not claimed. Accordingly, the process to file a reissue application was undertaken to correct the deficiencies.

A reason for the failure to claim the subject matter of claims 14 and 16 stems from the fact that the original patent is the U.S. version of German Application Serial No. 4002052, filed January 24, 1990. The original patent, thus, was intended to reflect the German priority case.

A reason that subject matter intended by the applicants to be claimed was not claimed, is that errors in the process of placing the claims, originally in the German language, in conformance with U.S. patent practice occurred. For example, the original German language version of the application claimed, in essence, that an inner frame is fastened to an outer housing through at least one clamping connection. This language was inadvertently omitted from claim 1 by U.S. patent counsel. Thus, claim 14 now recites first and second clip connections.

Additionally, the U.S. version of the case only recites, in claim 1 for example, that the check valve element is "clamped"

between the outer housing and the inner frame. The original German version recited a "clamping means", or "Klemm-Mittel."

Moreover, since I am principally German-speaking and reside in Germany, convenient communication to U.S. patent counsel of features of the invention, beyond that which was revised and translated from the German priority case, was not practicable. Accordingly, all aspects of the invention were not claimed.

Another reason that errors occurred, and that subject matter was not claimed, is that U.S. patent counsel agreed to cancel application claim 1 in order to gain allowance of other claims. However, U.S. counsel did not fully appreciate that the subject matter of application claim 1 was sought to be patented by the applicant. Accordingly, claim 16 has been added to the present reissue application to cover that subject matter.

Further, when the original reissue declaration was submitted, it was thought by the applicant and the applicant's attorneys that because countries such as Germany have strict unity of invention requirements, the claims may have been drafted, as claims typically are, to comply with these requirements. The U.S. Patent Office has requested in subsequent office actions that the applicant explain the requirement of the German Patent Office unity of invention policy that required him to not include the subject matter of the reissue claims in the parent application. Apparently, there has been a misunderstanding on this subject on the part of both the applicant and the U.S. Patent Office. First, it now appears that the original claim drafting may not have

contributed to the deficiency in the claims. Second, no formal action or position in this regard was taken by the German Patent Office (or the applicant) nor is there any specific policy known to the applicant that required such claim drafting. Notwithstanding this set of circumstances, however, reasons for errors with respect to the subject matter of claims 14 and 16 are delineated above. Thus, no further explanation is thought to be necessary by the applicant.

U.S. Patent No. 5,105,731 has not been and is not now being adjudicated in any court.

POWER OF ATTORNEY

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

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I hereby declare that all statements made hereof of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole inventor: Willibald Kraus

Inventor's signature *Willibald Kraus*

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